



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,883	11/26/2001	Arvind A. Bhagwat	55859-019	3120

7590

04/09/2003

Willem F Gadiano
McDermott Will & Emery
600 13th Street NW
Washington, DC 20005

EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 04/09/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,883

Applicant(s)

BHAGWAT ET AL.

Examiner

David A Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 4-8, 14 and 15, drawn to an isolated strain of *Bradyrhizobium* not expressing SEQ ID NO: 1, and a method of using the strain to increase nodulation of a leguminous plant.

Group II, claim(s) 1, 2, 4-8, 14 and 15, drawn to an isolated strain of *Bradyrhizobium* not expressing SEQ ID NO: 2, and a method of using the strain to increase nodulation of a leguminous plant.

Group III, claim(s) 3, drawn to an isolated strain of *Bradyrhizobium* not expressing a fusion of SEQ ID NO: 2 and SEQ ID NO: 1, where SEQ ID NO: 1 is upstream of SEQ ID NO: 2.

Group IV, claim(s) 9-11, drawn to an isolated nucleotide sequence of SEQ ID NO: 1.

Group V, claim(s) 9-11, drawn to an isolated nucleotide sequence of SEQ ID NO: 2.

Group VI, claim(s) 12-13, drawn to a plant seed coated with a *Bradyrhizobium* not expressing SEQ ID NO: 1.

Group VII, claim(s) 12-13, drawn to a plant seed coated with a *Bradyrhizobium* not expressing SEQ ID NO: 2.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the groups do not share a special technical feature as outlined below.

The special technical feature of Group I is an isolated strain of *Bradyrhizobium* that does not express SEQ ID NO: 1, and a first method of using the strain to increase nodulation of a

Art Unit: 1636

leguminous plant. The special technical feature of Group II is an isolated strain of *Bradyrhizobium* that does not express SEQ ID NO: 2, and a method of using the strain to increase nodulation of a leguminous plant. The special technical feature of Group II is different from that of Group I because it involves the non-expression of a different nucleotide sequence, said sequence having a different structure and function, therefore having a different technical feature.

The special technical feature of Group III is an isolated strain of *Bradyrhizobium* that does not express a fusion of SEQ ID NO: 1 upstream of SEQ ID NO: 2, where neither sequence is expressed. This special technical feature is different from that of Group I because it involves the non-expression of a different nucleotide sequence, said sequence having a different structure and function, therefore having a different technical feature.

The special technical feature of Group IV is an isolated gene represented by SEQ ID NO: 1. This special technical feature is distinct from that of Group I because the nucleotide sequence is structurally and functionally different from a strain that does not express the sequence.

The special technical feature of Group V is an isolated gene represented by SEQ ID NO: 2. This special technical feature is distinct from that of Group I because the nucleotide sequence is structurally and functionally different from a strain that does not express a completely different sequence.

The special technical feature of Group VI is a second method of using a *Bradyrhizobium* strain that does not express SEQ ID NO: 1, the purpose being the coating of a plant seed. This special technical feature is different from that of Group I because it involves different method steps.

The special technical feature of Group VII is a method of using a *Bradyrhizobium* strain that does not express SEQ ID NO: 2, the purpose being the coating of a plant seed. This special technical feature is different from that of Group I because it involves different method steps, and a different strain with a different non-expressed nucleotide sequence.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1636

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
January 11, 2003

Gerald G. Heffers Jr.
PATENT EXAMINER
Gerald G. Heffers Jr.
A. U. 1636